

15. (No Change) The method of claim 12 wherein translating the received input voice signals is performed with the personal digital assistant.

### **REMARKS**

Applicant has carefully reviewed and considered the second Office Action mailed on April 10, 2001, and the references cited therewith.

Claims 1-3 are canceled and claims 4-15 remain pending in this application.

Applicant traverses the rejection of claims 4-15 and requests reconsideration, because the cited references fail to provide a motivation to combine.

#### ***Rejection of Claims 1 and 3 under 35 U.S.C. §102 and §103***

Claims 1 and 3 were rejected under 35 U.S.C. §102(b) as being anticipated by Ohashi (U.S. Patent No. 5,581,783).

Claims 1 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Konishi (JP 410093671).

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ohashi (U.S. Patent No. 5,581,783) in view of *Applicant's Admitted Prior Art (AAPA)* as applied to claims 1, 3-6, and 8-15 above, and further in view of Epperson (U.S. Patent No. 5,247,137).

Claims 1-3 are canceled.

#### ***Claims 4-6 and 8-15 are Patentable under 35 U.S.C. §103***

Claims 4-6 and 8-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohashi (U.S. Patent No. 5,581,783) in view of *Applicant's Admitted Prior Art (AAPA)*.

Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ohashi (U.S. Patent No. 5,581,783) in view of *Applicant's Admitted Prior Art (AAPA)* as applied to claims 1, 3-6, and 8-15 above, and further in view of Epperson (U.S. Patent No. 5,247,137).

Applicant traverses the rejection of claims 4-15 and requests reconsideration because the references fail to provide a motivation to combine.

A *prima facie* case of obviousness has not been established for claims 4-15. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the

references or to combine reference teachings. MPEP 2143. The prior art must suggest the desirability of the claimed invention. MPEP 2143.01. The application itself may not be used as a basis for the motivation to combine to arrive at the claimed invention. MPEP 2143. There is no motivation to combine Ohashi and the background section of Applicant's specification that is found in either Ohashi or the background section.

In the background section, Applicant identified an unfulfilled need for a mobile personal computing device which allows a user to enter information using both a touch screen and voice commands. (Applicant's Specification, page 2 lines 1-2). Recognition of an unrecognized problem militates in favor of patentability. The background section states "mobile personal computing devices, such as lap-top computers and personal digital assistant (PDA) devices, are available with touch screens as input devices." (Applicant's Specification, page 1 lines 23-25). However, there is no motivation to combine the subject matter of Ohashi with a PDA in the background section.

The Office Action does not provide a source for the supposed motivation that "this will provide easy to carry with a grater mobility." (Office Action, dated April 10, 2001, page 4, 2nd full paragraph). Ohashi does not disclose a PDA with a touch screen and Ohashi does not disclose a motivation to combine with a PDA. Ohashi is directed to capturing multimedia information and transferring it to a computer. (Ohashi, col. 1 lines 11-15). Ohashi does not address the mobility of the computer. The tendency to resort to "hindsight" based upon Applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. MPEP 2142.

**Conclusion**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 371-2160 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 10th day of July, 2001.

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